

REMARKS

Claims 1-4 and 18-23 were withdrawn from consideration. Claims 5-17 were pending. With this Amendment and Response, claims 1-23 are cancelled. New claims 24-35 have been added. After entry of the instant amendment, claims 24-35 stand pending and under consideration.

I. PRIORITY

The PTO notes that a certified copy of the priority document has not been received. Applicants submitted a certified copy of European Patent Application No. 97121151.1 on June 5, 2003. Applicants respectfully request that the objection be withdrawn.

II. INFORMATION DISCLOSURE STATEMENT

The PTO objects that the listing of references in the specification is not a proper information disclosure statement. Applicants submit herewith a copy of the Information Disclosure Statement and copy of Form PTO-1449 from the parent application, U.S. Serial No. 09/204,208.

III. AMENDMENT TO THE SPECIFICATION

The specification has been amended to consistently recite the sequence identifiers and figures and to correct minor grammatical errors. In addition, the short description of Figure 2 (page 7) and a sentence referring to Figure 2 (page 8) have been amended to correct non-standard English and to more clearly describe Figure 2.

No new matter has been introduced. Applicants respectfully request that the objection to the specification be withdrawn.

IV. NEW CLAIMS

New claim 24 recites a DNA sequence encoding substantially SEQ ID NO:11. Support for new claim 24 can be found in the specification, for example, at page 8, lines 1 to 10, page 9, lines 5 to 8 and claim 8 as originally filed.

New claim 25 recites the DNA sequence of claim 24 encoding SEQ ID NO:11. Support for new claim 25 can be found in the specification, for example, at page 8, lines 1 to 10 and page 9, lines 5 to 9 and in claim 8 as originally filed.

New claim 26 recites the DNA sequence of claim 25 that comprise nucleotide sequence SEQ ID NO:10. Support for new claim 26 can be found in the specification, for example, at page 9, lines 5-9 and claim 9 as originally filed.

New claims 27-29 recite a vector comprising the DNA sequence of claim 24, 25 and 26, respectively. New claim 30 recites the vector of claim 29 that is p Δ_{2-225} AR₄. Support for new claims 27-30 can be found in the specification, for example, page 6, lines 15 to 26, and claim 15 as originally filed.

New claims 31-34 recite a host cell transformed with the vector of claim 27, 28, 29 and 30, respectively. New claim 35 recites the host cell of claim 34 that is *E. coli* GA1. Support for new claims 31-35 can be found in the specification, for example, page 6, lines 15 to 26 and claim 17 as originally filed.

Applicants submit that new claims 24-35 are fully supported by the specification and respectfully request entry thereof.

V. CLAIM REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 5-17 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite as it was allegedly unclear “when a modified DNA polymerase becomes a modified form of a DNA polymerase other than a DNA polymerase from *Carboxydotherrnus hydrogenofomans*.”

Applicants have cancelled claims 5-17 rendering the rejection of these claims moot. Applicants respectfully request that the rejection be withdrawn.

VI. CLAIM REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH

A. Written Description

Claims 5-7, 10 and 11 stand rejected under 35 U.S.C. §112, first paragraph for allegedly failing to meet the written description requirement. Applicants have cancelled claims 5-7, 10 and 11 rendering the rejection of the claims moot.

Applicants respectfully request that the rejection under 35 U.S.C. §112, first paragraph be withdrawn.

B. Enablement

i. Claims 5-7, 10 and 11

Claims 5-7, 10 and 11 stand rejected under 35 U.S.C. §112, first paragraph as allegedly not being enabled as to a DNA sequence encoding a “modified DNA polymerase.” Applicants have canceled claims 5-7, 10 and 11 rendering rejection of the claims moot.

Applicants respectfully request that the rejection under 35 U.S.C. §112, first paragraph be withdrawn.

ii. Claims 15-17

The PTO contends that there is no showing that the vector and strain of claims 15-17 are publicly known and freely available. Applicants have canceled claims 15-17 rendering the rejection moot. New claims 30 and 35 recite, the vector, p Δ_{2-225} AR₄, and host cell, *E. coli* GA1, respectively. Applicants submit herewith a Declaration of Dr. Waltraud Ankenbauer, attesting that biological deposits of p Δ_{2-225} AR₄ and *E. coli* GA1 have been deposited with the DSMZ-Deutsche SAMMLUNG VON MIKROORGANISMEN UND ZELLKULTUREN GmbH under the terms of Budapest Treaty.

Applicants respectfully request that the rejection be withdrawn.

VII. NEW CLAIMS 24-35 AND 35 U.S.C. §112, FIRST PARAGRAPH

Applicants submit that new claims 24-35 are described and enabled by the specification as required by 35 U.S.C. §112, first paragraph.

The specification describes the nucleic acid sequence encoding the modified DNA polymerase in SEQ ID NO:10 and the amino acid sequence comprising the modified DNA polymerase in SEQ ID NO:11 (page 6, lines 15 to 26 and Figure 1). The PTO acknowledges that the specification provides the amino acid sequence of SEQ ID NO:11 (page 4, Office Action mailed April 8, 2003) and enablement of nucleotide sequence SEQ ID NO:10 (page 5, Office Action mailed April 8, 2003). Further, as discussed above, Applicants submit herewith a Declaration of Deposit regarding vector p Δ_{2-225} AR₄ and host cell *E. coli* GA1 under terms of the Budapest treaty, making the samples publicly known and freely available.

Applicants submit that new claims 24-35 meet the criteria for patentability under 35 U.S.C. §112, first paragraph.

CONCLUSION

Applicants submit that claims 24-35 satisfy all the criteria for patentability and are in condition for allowance. An early indication of the same is therefore kindly solicited.

Applicants believe no fee, other than a one month extension of time, is due with this response. However, pursuant to 37 C.F.R. §1.136 (a)(3), the Commissioner is authorized to charge all required fees, fees under 37 C.F.R. §1.17 and all required extension of time fees, or credit any overpayment, to Pennie & Edmonds LLP, U.S. Deposit Account No. 16-1150 (Order No. 1803-332-999).

Respectfully submitted,

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